

REMARKS/ARGUMENTS

The amendments set out above and the following remarks are responsive to the points raised in the Office Action dated August 28, 2009. In view of the amendments set out above and the following remarks, reconsideration is respectfully requested.

The Pending Claims

Claims 1 and 17 are amended, and claim 18 is added, to describe the invention more clearly. Claims 1-18 are pending. No new matter is added, and support for the amended claim language may be found within the original specification, claims, and drawings. Support for claims 1 and 17 may be found in the specification at, e.g., paragraph [0005]. Support for claim 18 may be found in the specification at, e.g., paragraphs [0004]-[0005], [0029], [0032], and original claim 1.

The Office Action

Claims 1-4, 6, 10-12 and 16 were rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent Application Publication No. 2004/0136774 to O'Boyle (hereinafter, "O'Boyle") in view of U.S. Patent Application Publication No. 2003/0030269 to Hernandez (hereinafter, "Hernandez") and further in view of U.S. Patent No. 4,932,520 to Ciarcia et al. (hereinafter, "Ciarcia").

Claims 5 and 15 were rejected under § 103 as unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent No. 5,651,628 to Bankes et al. (hereinafter, "Bankes").

Claim 7 was rejected under § 103 as unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent Application Publication No. 2002/0089166 to Schwartz (hereinafter, "Schwartz").

Claims 8-9 and 13-14 were rejected under § 103 as unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent Application Publication No. 2004/0253046 to Africa (hereinafter, "Africa").

Claim 17 was rejected under § 103 as unpatentable over O'Boyle in view of Hernandez and further in view of Ciarcia and U.S. Patent No. 2,551,784 to Bauer (hereinafter, "Bauer").

Each of these rejections is separately and respectfully traversed.

The Office Action states that "...Applicant has failed to set forth an argument including sufficient terms and basis to enable Examiner to respond" (page 9). It is respectfully pointed out that the Office Action appears to have considered only the Supplemental Reply filed June 17, 2009, which was supplemental to and in addition to the Reply to the Office Action mailed February 26, 2009, which was filed May 26, 2009. The Office Action does not appear to have considered any of the remarks set forth in the Reply filed May 26, 2009.

The rejections are traversed for the reasons set forth in the Reply filed May 26, 2009 and the Supplemental Reply filed June 17, 2009, as well as for the reasons set forth below.

For an obviousness rejection to be maintained, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art and must provide an appropriate supporting rationale for the proposed modification (*KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385 (2007); (MPEP § 2141). In the case at hand, the cited combination of references, O'Boyle, Hernandez, and Ciarcia, fails to teach or suggest each and every element of the claim, and the Office Action fails to explain why it would have been obvious to one of ordinary skill in the art to modify O'Boyle to have separation sheets that are inseparable from a binder that joins front and back leaves together, as claimed in claims 1 and 17.

O'Boyle discloses a notebook 10 comprising a cover including a front leaf 17 and a back leaf 18, a binder (spiral binding 11) joining the front and back leaves together, and inner notebook pages 16 connected to the binder between the front and back leaves. The Office Action correctly acknowledges that O'Boyle fails to disclose i) the notebook pages being detachable and ii) separation sheets.

Although Hernandez discloses pages separable via perforations (par. [0054]), Hernandez further indicates that the detached pages, on which expense summaries are listed,

are submitted to the accounting department or the department that processes expense reports (paragraph [0071]). Accordingly, the detached pages of Hernandez are not to be inserted within the notebook 10 of Hernandez. Thus, one of ordinary skill in the art looking for a way to store detached sheets within a notebook would not look to Hernandez. Accordingly, the obviousness rejection based on the combination of Hernandez with O'Boyle cannot be maintained.

Ciarcia discloses a plurality of clear plastic envelopes (40) attached to one another to a binder (42) to which a backing backing securement flap (46) is attached (Figure 3). The securement flap (46) is inserted into the slot (26) on the inside face (24) of the right hand cover (14), parallel to the edge (15) joining the left hand cover to the right hand cover 14 (Ciarcia col. 3, lines 32-40).

However, contrary to the Office Action's assertion, Ciarcia fails to disclose separation sheets with tabs *inseparably* connected to a binder that joins the front and back leaves together, as claimed in claims 1, 17, and 18. In Ciarcia, the envelopes (40) are fastened into the wallet by removably inserting the securement flap attached to the envelopes (40) into a slot (26) on the inside face of the cover. It is clear that the binder (42) to which the envelopes (40) are attached is independent from the edge (15) binding the left and right hand covers (12, 14). Thus, the binder (42) is clearly distinguishable from a binder that joins the front and back leaves together, and the envelopes of Ciarcia must be removably inserted. Because the plastic envelopes (40) of Ciarcia must be removable, and are not *inseparately* connected to a binder that joins front and back leaves together, Ciarcia does not cure the deficiencies of O'Boyle. In no way does Ciarcia even suggest a notebook including inner separation sheets *inseparably* connected to a binder that joins the front and back leaves together, as claimed in claims 1, 17, and 18. Without such disclosure or suggestion, one of ordinary skill in the art reading Ciarcia would not be led to a notebook including inner separation sheets inseparably connected to a binder that joins the front and back leaves together, as claimed in claims 1, 17, and 18. Nor has the Office Action explained why providing separation sheets that are inseparable from a binder that joins front and back leaves together would be obvious to one of ordinary skill in the art. Accordingly, the combination of O'Boyle, Hernandez, and Ciarcia does not render the subject matter of claims 1, 17, and 18 obvious.

In contrast to the complicated structure provided by Ciarcia, the notebook pages are, advantageously, simply inserted between adjacent inner separation sheets of the notebook claimed in claims 1, 17, and 18. Ciarcia fails to disclose or suggest that notebook pages can simply be inserted between adjacent inner separation sheets or envelopes 40 of the notebook. Accordingly, the obviousness rejection cannot be maintained.

In addition, one of ordinary skill in the art would be discouraged from combining the teachings of Ciarcia with O'Boyle. Ciarcia includes a plurality of envelopes 40 with the tabs 52, open top edges 48 to permit backing sheets 50 to be slipped therein, and corner pockets 62. One of ordinary skill in the art would be discouraged from including the envelopes of Ciarcia in a notebook because the envelopes of Ciarcia have a complicated structure that would increase the manufacturing costs for a notebook.

The Office Action alleges that Ciarcia teaches attaching the envelopes (40) to a spiral binding at col. 3, lines 64-67. The Applicants disagree. Nowhere does Ciarcia teach or suggest attaching the envelopes to a spiral binding. Accordingly, claim 10 is not obvious over the combination of O'Boyle, Hernandez, and Ciarcia.

With respect to claim 17, the Office Action correctly acknowledges that O'Boyle, as modified by Hernandez and Ciarcia, fails to disclose at least one closing means including an elastic band fastened to one of the front and back leaves by rivets sliding relative to the leaf via eyelets, wherein the elastic band is adapted to be pulled over corners of the superimposed inner separation sheets so that the separation sheets are adapted to secure notebook pages between the separation sheets and notebook pages attached to the binder are available for use.

These additional features of claim 17 provide the important advantage that a user can write on the notebook pages while keeping detached pages inserted between the inner separation sheets located between the notebook pages and one of the front and back leaves of the notebook using the claimed closing means. Therefore, the notebook can, advantageously, be used vertically without losing the detached pages.

Bauer discloses a book protector formed from a sheet of material 10, which is scored along the lines 18a-18a to provide the back wall 19 and swinging side walls 20. The edges of the side walls are folded over at the regions indicated by the numerals 21-21 to provide flaps 22 which are adapted to engage the inside surface of the covers of a book (Bauer, col. 1, lines

32-43). A piece of elastic cord 27 is supported at each of its ends by a corresponding fastener portion 24 of one flap 22, and is supported at its mid-portion by the button 26 of the flap 22 (Bauer, col. 2, lines 5-9). In use, the covers of a book are inserted in the pockets provided by the flaps 22 which holds the book against displacement. The pages at the left and right sides of the book are held down by the elastic cords 27. To turn the page, the reader slips that page out of engagement with the corresponding elastic cords 27 and slips it under the elastic 27 of the opposite side of the book holder (Bauer, col. 2, lines 10-23).

Contrary to the assertion of the Office Action, the combination of Bauer with O'Boyle, as modified by Hernandez and Ciarcia, would not result in the claimed notebook. Instead, such a combination would conduct one of ordinary skill in the art to insert the covers 17, 18 of the notebook of O'Boyle in the pockets formed by the flaps 22 of the book protector of Bauer, with the block of envelopes 40 of Ciarcia removably attached to the back cover 18 of O'Boyle, so that the notebook pages attached to the binder 11 of O'Boyle could be held down by the elastic cords 27 as taught in Bauer. The resulting structure is very different from the claimed notebook and does not suggest the structure of the claimed notebook in any way.

In Bauer, only the covers of a book are inserted into the pockets formed by the flaps 22 of the book protector and the elastic cords 27 are intended to hold the pages at the left and right sides of the book. Bauer does not disclose or suggest pulling the elastic band over corners of inner separation sheets that are inseparably connected to the binding to secure notebook pages separated from the binder between the inner separation sheets, as claimed in claim 17. Accordingly, the obviousness rejection of claim 17 cannot be maintained.

New claim 18 recites that one of the front and back leaves includes flaps along its upper, lower, and side edges and which, when in a folded-down position with respect to the front or back leaf, form a pocket for storing inner separation sheets capable of containing therebetween notebook pages separated from the binder, and wherein the elastic band is adapted to be pulled over corners of the folded-down flaps storing inner separation sheets.

With respect to claim 7, the Office Action alleges that Schwartz teaches the inclusion of flaps (corners 3) along the upper, lower, and side edges of a substrate sheet (Figure 1).

Schwartz discloses dual corner pockets 32 and 32' formed by tab corners, 3 and 3' which are welded or glued for attachment to the back panel 1a (paragraph [0052]). The dual

corner pockets of the pocket 1 have a triangular shape and are intended to receive the corners of leaves 80, 81, and 82, as shown in Schwartz Figure 1.

The Applicant maintains that Schwartz fails to teach or suggest flaps along upper, lower, and side edges of the leaf, as claimed in claim 7, and which, when in a folded-down position with respect to the front or back leaf, form a pocket for storing inner separation sheets capable of containing therebetween notebook pages separated from the binder, as claimed in claim 18.

Contrary to the assertion of the Office Action, the combination of Schwartz with O'Boyle, as modified by Hernandez and Ciarcia, would not result in the claimed notebook. Instead, such a combination would result in the front cover 17 of O'Boyle with dual corner pockets having a triangular shape and into which could be inserted the corners of the sheets 16, connected to the binder 11 of O'Boyle. The resulting structure is very different from the claimed notebook and does not suggest the structure of the claimed notebook in any way. Accordingly, claim 18 is also patentable over the cited references.

The dependent claims are also patentable because they depend from, and include the limitations of, independent claim 1.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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Amendment or ROA - Regular (SML/mlg)